

REMARKS

Claims 1 - 32 are pending in the Application. Claims 1-8 and 18-23 are cancelled. Claims 9, 11, 16, 24 and 31 are amended. Claims 9-17 and 24-32 are rejected under 35 U.S.C. §103(a). Applicant respectfully traverses these rejections for at least the reasons stated below and respectfully request the Examiner withdraw these rejections.

I. REJECTIONS UNDER 35 U.S.C. § 103

Claims 9-17 and 24-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Bellis et al.* (U.S. Patent Application No. 2003/0024982) (hereafter "*Bellis*") in view of *Novak* (U.S. Patent No. 5,497,314) (hereafter "*Novak*"). In response, Applicant respectfully traverses this rejection.

Claims 9 - 17

Independent amended claim 9, and its dependent claims 10 - 17, are not obvious in light of *Bellis*, *Novak*, or *Bellis* in view of *Novak* for any of the following reasons.

*Cited References Fail to Teach Every Element of Claim*

Rejections under §103 require that the cited references teach *every* element of the claim. M.P.E.P. §2143.03. *Bellis*, *Novak*, or *Bellis* in light of *Novak* fail to teach *every* element of amended claim 9. Therefore, amended claim 9 is not obvious in light of the cited references.

Amended claim 9 provides:

A check-out method ... comprising the steps of:

...

examining said product while said product is in said substantially enclosed area;

establishing ... physical features for said product while said product is in said substantially enclosed area;

...

deactivating said tag ... while said product is in said substantially enclosed area.

Thus, amended claim 9 "examine[s] said product", "establish[es] one or more physical features for said product", and "deactivat[es] said tag ... while said product is in said substantially enclosed area."

In contrast, the Office Action provides "*Novak* teaches ... that the physical characteristics of objects are measured in an enclosed area ... [I]t would have been obvious ... to include the ... measurement of physical characteristics in an enclosed area." (Office Action, Page 4). The Office Action fails to address the element in amended claim 9 concerning "deactivating said tag ... while said product is in said substantially enclosed area." It is the Examiner's burden to do so.

Consequently, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* because the references do not teach or suggest all of the elements of the claim (i.e., deactivating said tag ... while said product is in said substantially enclosed area.) M.P.E.P. §2143.03; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998)(§103 rejections must not rely on incorrect factual predicates

such as failing to appreciate differences between a claim and prior art.) As a result, amended claim 9 (and claims 10 - 17) are not obvious in light of the cited references.

*Cited References Teach Away from Claimed Invention*

Furthermore, amended claim 9 is not obvious in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* because the cited references teach away from the claimed invention. M.P.E.P. § 2145(D).

Amended claim 9 provides the following: "deactivating said tag ... while said product is in said substantially enclosed area." Doing so provides many advantages, one of which is the prevention of "sweethearting" by a thief. One example of "sweethearting" occurs when a thief uses a check-out system to deactivate a security tag on a first item that was or will be correctly paid for by a thief. While such a deactivation occurs, the thief places a second item (one he has no intention of paying for) in proximity to the first item. Consequently, the second item's security tag is wrongfully deactivated along with the first item's security tag. Amended claim 9 specifically addresses this issue because claim 9 "examine[s] said product", "establish[es] ... physical features for said product", and "deactivat[es] said tag ... while said product is in said substantially enclosed area." In short, amended claim 9 prevents sweethearting.

In contrast, *Bellis* provides that a "bagging station 270 may further include ... deactivators." (Paragraph 19). The bagging station 270 is located in open space and is consequently susceptible to sweethearting. (Figure 1). *Bellis* also allows for the deactivator to be "incorporated within the identification-code reader 120." (Paragraph 19). As was the case with the bagging station location, the identification-code reader is located in open space and is consequently susceptible to sweethearting. (Figure 1). Simply put, *Bellis* fails to even contemplate a significant advantage (i.e., prevention of sweethearting) provided by amended claim 9. Further, an open space teaches away and opposite from an enclosed area.

*Novak* cannot remedy *Bellis*' shortcoming because *Novak* doesn't even address deactivating security tags. Instead, *Novak* targets the assessment of physical characteristics of objects – not theft prevention.

Thus, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness for amended claim 9 (as well as claims 10 – 17) in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak*, considering the cited references cannot be modified or combined as proposed by the Examiner because they teach away from the claimed invention. M.P.E.P. § 2145(D).

*Cited References Address Different Problems*

In addition, amended claim 9 is not obvious in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* considering the cited references cannot be modified or combined as proposed by the Examiner because the references address different problems. M.P.E.P. § 2143.01.

As stated above, the Office Action states that *Bellis* addresses deactivation of security tags—an issue regarding amended claim 9. (Office Action, Page 4). However, *Novak* limits its focus to the assessment of physical characteristics of objects. *Novak* doesn't even address deactivating security tags.

Thus, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness for amended claim 9 (as well as claims 10 – 17) in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak*, considering the cited references cannot be modified or combined as proposed by the Examiner because the cited references address different problems (i.e., deactivation of security tags and assessment of physical characteristics). M.P.E.P. § 2143.01.

*No Motivation to Combine the Cited References*

Furthermore, amended claim 9 is not obvious in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* because the cited references cannot be modified or

combined as proposed by the Examiner due to the Examiner's failure to provide a motivation to combine the cited references. M.P.E.P. § 2143.01. In short, the Office Action fails to even address the motivation to combine the cited references.

Consequently, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness for amended claim 9 (as well as claims 10-17) in light of the cited references, considering those references cannot be combined or modified as proposed by the Examiner because there is no suggestion or motivation to modify or to combine the reference teachings. M.P.E.P. §2143.01; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (court requires the examiner to show a motivation to combine the §103 references).

Claims 24 - 32

As in the case with amended claim 9, independent amended claim 24, and its dependent claims 25 - 32, are not obvious in light of *Bellis*, *Novak*, or *Bellis* in view of *Novak* for any of the following reasons.

Amended claim 24 provides:

A check-out system...comprising:

...

a[n] ... evaluator for establishing ... physical features ... while said product is in said substantially enclosed area;

...

a deactivation device for deactivating said tag ... while said product is in said substantially enclosed area.

Thus, amended claim 24 "establish[es] physical features" and "deactivat[es] said tag ... while said product is in said substantially enclosed area." As in the case with amended claim 9, the Office Action fails to address whether the cite references

"deactivat[e] said tag ... while said product is in said substantially enclosed area." Consequently, the Examiner has failed to prove a *prima facie* case of obviousness because *Bellis*, *Novak*, or *Bellis* in view of *Novak* do not teach or suggest all of the elements of amended claim 24.

Also, as in the case with amended claim 9, amended claim 24 is not obvious in light of *Bellis*, *Novak*, or *Bellis* in view of *Novak* because the cited references teach away from the claimed invention. For example, *Bellis* provides that a "bagging station 270 may further include ... deactivators" wherein the bagging station is located in open space and is consequently susceptible to sweethearting. Amended claim 24 provides "deactivating said tag ... while said product is in said substantially enclosed area."

In addition, as in the case with amended claim 9, *Bellis*, *Novak*, or *Bellis* in view of *Novak* cannot be modified or combined as proposed by the Examiner because the references address different problems (i.e., deactivation of security tags and assessment of physical characteristics). Again, *Novak* doesn't even address deactivating security tags—an element in amended claim 24.

Finally, as in the case with amended claim 9, amended claim 24 is not obvious in light of *Bellis*, *Novak*, or *Bellis* in view of *Novak* because the cited references cannot be modified or combined as proposed by the Examiner due to the Examiner's failure to provide a motivation to combine the cited references. The Office Action fails to even address the motivation to combine the cited references.

In short, amended claim 24, and its dependent claims 25 - 32, are not obvious in light of *Bellis*, *Novak*, or *Bellis* in view of *Novak* for at least the above reasons.

III. CONCLUSION

As a result of the foregoing, it is asserted by Applicant that claims 9-17 and 24-32 in the Application are in condition for allowance, and Applicant respectfully requests an allowance of such claims. Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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